

## REMARKS

The above amendments and these remarks are responsive to the Office action dated January 28, 2004. Claims 1-30 are pending in the application. In the Office action, claims 9-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 17-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,945,689 to Johnson, Jr. (“Johnson”). Claims 1-16 and 20-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 3,878,638 to Benjamin. Applicant is also directed to make changes to the priority claim and the specification.

In view of the amendments above, and the remarks below, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

### *Objections to the Specification and Rejections under 35 U.S.C. § 112*

First, applicant has made the requested changes to the priority claim and the abstract.

Next, regarding the term “sheet-like” of claim 9, the specification discloses at page 14, lines 1-2 that “the fluent material confinement system is collapsed down to a substantially flat sheet-like shape,” and points to Fig. 5 to illustrate this point. In light of the description of “sheet-like” as substantially flat, applicant believes that claim 9 is not indefinite, and complies with the requirements of § 112, second paragraph.

Regarding the term “strip-like” of claim 10, claim 10 is herein amended to recite that the at least one collapsed configuration includes a substantially flattened, narrow configuration. Applicant believes claim 10 as amended complies with the requirements of § 112, second paragraph.

**Rejections under 35 USC § 102**

Applicant respectfully traverses the assertion that claim 17 is anticipated by Johnson. This is because Johnson does not show a connecting structure including a tongue formed in the end of the selected strip at a location spaced from the perimeter of the end of the selected strip. Instead, the tongue of Johnson extends to the edge of the strip. However, to clarify this difference, applicant herein amends claim 17 to recite that the tongue is formed from a slot formed in the end of the selected strip at a location spaced from the perimeter of the end of the selected strip.

In contrast, Johnson does not show such a connecting structure. Instead, Johnson shows two different connectors: a slot that extends to the perimeter of the strip in a vertical direction (for example, at 114A in Fig. 1), and a circular hole formed in the end of the strip (at 114B in Fig. 4). The slot connector extends through at least half of the width of the strip, and is configured to be connected to a complementary slot connector on an adjacent strip. When the slot connector is connected to an adjacent slot connector, the ends of the strips (beyond the slot connectors) are not held together in any manner by the connector. Therefore, the end of the strips can, and often do, dog-ear (i.e. bend over into the cell formed by the ends of adjacent grids) under the force of sand being added to the grids. Furthermore, once the ends of the strips dog-ear, sand can then wedge the dog-

eared connector further and further away from its correct position. This blocks sand from filling the grids, and thus introduces weaknesses in a structure formed by the grids. Where the grids are used to form a flood protection structure, such weaknesses can cause catastrophic failure of the structure.

The circular hole connector likewise presents problems. The Johnson specification discloses that a rod, cable or the like can be passed through the holes to connect adjacent grids together. Such a connection would do nothing to hold the ends of two connected strips together. Therefore, cells formed at the border between two grids may have gaps in their walls through which sand can easily escape.

In contrast, the connecting structures recited in claim 17 hold the ends of adjacent strips together, and help to prevent dog-earing from occurring. Because the slot that forms the tongue is spaced from the perimeter of the strip, the perimeter of the end of the strip is unbroken, and the strips thus resist dog-earing when sand is added. Furthermore, the tongue-and-slot connection holds the ends of the strips together so that sand cannot easily escape the border cells. These advantages help to produce a much stronger and secure flood barrier structure than those disclosed by Johnson.

For at least these reasons, amended claim 17 is not anticipated by or obvious over Johnson, and is therefore in condition for allowance. Furthermore, claims 18-19 depend from and include all of the elements of claim 17, and are therefore also not anticipated by, or obvious over, Johnson.

**Rejections under 35 USC § 103**

Applicant also respectfully traverses the assertion that claim 1 is obvious over Johnson in view of Benjamin. This is because these references cannot be properly combined to establish a *prima facie* case of obviousness for claim 1. One of the requirements for establishing a *prima facie* case of obviousness is to show some suggestion or motivation to modify the reference or to combine reference teachings. MPEP § 2143. The teaching or suggestion to make the claimed combination must be found in the prior art, rather than in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). To do otherwise would be to improperly “[use] that which the inventor taught against its teacher.” *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) (citing *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)). Furthermore, the “factual question of motivation . . . [cannot] be resolved on subjective belief and unknown authority.” *Lee* at 1344.

The motivations to combine Johnson and Benjamin cited in the Office action of 1/28/2004 are inadequate to make a *prima facie* showing of obviousness because they are based on subjective belief or unknown authority, and utilize applicant's teachings against applicant's own claims. For example, regarding claim 1, the Office action states “[t]he motivation would have been to clearly instruct a user how to prop or collapse the system.” However, the prior art contains no such motivation. Instead, Johnson states that its grid is easy to deploy (Johnson, col. 2, ll. 54-55). Indeed, the grid configuration of Johnson moves quite easily between the two collapsed configurations and the deployed configuration, and more importantly, cannot be easily moved into any other

configurations. Therefore, the ease of operation of the Johnson grid itself would offer no motivation to provide any sort of deployment indicator on the grid. Furthermore, Johnson does not at all address the difficulties of working in inclement weather with poor visibility. Instead, these considerations are taught only in applicant's disclosure, and therefore cannot be used as a basis for a suggestion to combine references.

Benjamin also does not provide any motivation to combine. Unlike the Johnson grid, the origami games of the Benjamin reference require multiple complex, precise folds of a sheet of paper to construct an intricate piece of art. Any mistakes in folding may prevent a user from achieving the desired finished shape. This is not a problem encountered with the grid of the Johnson reference. Moreover, the Benjamin reference also does not disclose or suggest the difficulties of working in inclement weather conditions, where poor visibility is a problem. Thus, the cited motivation to combine the Johnson and Benjamin references does not come from the prior art, but instead comes either from the applicant's own teachings or from subjective belief. In either case, this is inadequate under *Lee* and *Gore* to provide a motivation to combine. Therefore, for at least this reason, claim 1 is not obvious over Johnson in view of Benjamin, and is in condition for allowance. Furthermore, claims 2-16 depend from and include all of the elements of claim 1, and are therefore also in condition for allowance.

Claim 1 is also not obvious over Johnson in view of Benjamin because these two references are from nonanalogous fields of art, and therefore cannot be properly combined in a § 103 rejection. "In order to rely on a reference as a basis for rejection . . . , the reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the inventor was concerned."

*In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). Overlap in structure and function between references may indicate that the references are analogous. *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973).

Benjamin cannot be properly combined with Johnson because it is neither in applicant's field of art, nor reasonably pertinent to the particular problems with which claim 1 is concerned. The problems with which the device of claim 1 is concerned include problems with rapid deployment of a temporary barrier during inclement weather and other low-visibility conditions. A reference in the origami arts would not logically have commended itself to an inventor's attention in considering such a problem. For example, origami is practiced with small sheets of paper, and is concerned with making many intricate, precise folds to produce works of art. It is not thought of as an activity related to flood protection or barrier construction, and is not often thought of as an activity practiced in inclement weather or under other low visibility conditions. Furthermore, a small sheet of paper with lines indicating where folds are to be made has little, if any, structural similarity to a large, sturdy grid for holding sand, gravel or the like. Therefore, the device disclosed in the Benjamin reference is different in structure, function and purpose than either the device disclosed in Johnson or that defined by claim

1. For at least this reason, the Benjamin reference is not in a field of art considered

reasonably pertinent to the field of art of claim 1 or of Johnson, and cannot be properly combined with Johnson for a § 103 rejection.

Next, claim 20 is also rejected as obvious over Johnson in view of Benjamin. The motivation to combine for this claim cited in the Office action is apparently the same as for claim 1, as the rejection states that “the method steps recited therein are inherent to the use of the device disclosed by the combination of Johnson, Jr. . . . and Benjamin . . .” Therefore, this claim is not obvious over Johnson in view of Benjamin for the same reasons as given above for claim 1. Furthermore, claims 21-25 depend from and include all of the elements of claim 20, and are therefore also in condition for allowance.

Claim 26 is also rejected as obvious over Johnson in view of Benjamin. The same motivation to combine these references is given for this claim as for claim 1. Therefore, claim 26 is not obvious over Johnson in view of Benjamin for the same reasons as given above for claim 1. Furthermore, claims 27-29 depend from and include all of the elements of claim 26, and are therefore also in condition for allowance.

Finally, claim 30 is rejected for the same reasons as claim 20. Therefore, claim 30 is not obvious over Johnson in view of Benjamin for the same reasons as given above for claim 20.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner

has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.

*M. Matthews Hall*  
M. Matthews Hall  
Registration No. 43,653  
Customer No. 23581  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679  
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop NON-FEE AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on March 29, 2004.

*Renee Knight*  
Renee Knight